

REMARKS

This Amendment is a submission under 37 C.F.R. §1.114 for a Request for Continued Examination (RCE).

In the Office Action, claims 38-43, 45-49 and 52-60 were rejected. More specifically,

- Claims 38-39, 42-43 and 45-49 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,165,834 (Agarwal);
- Claims 38-39, 42-43 and 45-49 were rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Agarwal and U.S. Patent 5,866,453 (Prall);
- Claims 40-43, 45 and 48 were rejected under 35 U.S.C. § 103(a) as being obvious over either the combination of Agarwal and U.S. Patent 6,222,722 (Fukuzumi) or the combination of Agarwal, Prall and Fukuzumi;
- Claims 38-43, 45-49 and 52-60 were rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Fukuzumi and Agarwal; and
- Claims 38-43 and 45-49 were rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Fazan, Agarwal and Fukuzumi.

For the reasons set forth hereinbelow, Applicants request that the rejections associated with the pending claims be withdrawn.

§ 102 Rejections

Claims 38-39, 42-43 and 45-49

Applicants respectfully submit that independent claim 38, and claims 39, 42-43 and 45-49 which depend therefrom, are not anticipated by Agarwal. Claim 38 recites, among other things, “forming a first electrode in a recess of a substrate assembly ... wherein the first electrode extends above an uppermost surface of the substrate assembly” and “forming a dielectric on the first electrode and the uppermost surface of the substrate assembly.”

With respect to Figure 5 of Agarwal, Applicants submit that the Office Action fails to identify the specific location considered to be the uppermost surface of the substrate assembly disclosed by Agarwal. Applicants also note that the Office Action merely cites Figure 5 of Agarwal as teaching “forming a dielectric 40 on the first electrode 38” - **not** “forming a dielectric on the first electrode and the uppermost surface of the substrate assembly” as recited in claim 38. Applicants respectfully submit that doing so would define the uppermost surface of the substrate assembly in a manner inconsistent with the Examiner’s determination that Figure 5 of Agarwal teaches “forming a first electrode in a recess of a substrate assembly ... wherein the first electrode extends above an uppermost surface of the substrate assembly” as recited in claim 38.

Accordingly, Applicants submit that claims 38-39, 42-43 and 45-49 are not anticipated by Agarwal and respectfully request that the § 102(e) rejections associated with these claims be withdrawn.

§ 103(a) Rejections

Claims 38-39, 42-43 and 45-49

Applicants respectfully submit that independent claim 38 is nonobvious over the combination of Agarwal and Prall because, among other things, there is no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified these references to realize the invention of claim 38. *See* MPEP § 2143 (stating that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings).

Although Prall, referring to Figures 7 and 17 thereof, teaches storage poly 40 (referred to in the Office Action as the first electrode) extending above an uppermost surface of a lower insulating layer 36 or an intermediate insulating layer 45 (each referred to in the Office Action as the substrate assembly), Applicants respectfully disagree with the Examiner's determination that it would have been obvious to combine Agarwal with Prall to construct a capacitor by the method recited in claim 38 because of "the desirability to form another capacitor structure, wherein capacitance is increased by removing the container insulating walls from outer periphery of the storage nodes." Applicants note that MPEP § 2143.01 specifically states that (1) the prior art must suggest the desirability of the claimed invention and (2) the level of skill in the art **can not be relied upon** to provide the suggestion to combine references.

Applicants also submit that a § 103(a) rejection of claim 38 based on the combination of Agarwal and Prall would be a hindsight reconstruction, using Applicants' claim as a template to construct a capacitor by the method recited in claim 38 by picking and choosing isolated disclosures

from the prior art. Such hindsight reconstruction is improper and impermissible under the law. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143.01.

Applicants further submit that claims 39, 42-43 and 45-49, which depend from claim 38, are also nonobvious over the combination of Agarwal and Prall. *See* MPEP § 2143.03 (stating that if an independent claim is nonobvious under § 103(a), then any claim depending therefrom is nonobvious). Accordingly, Applicants respectfully request that the § 103(a) rejections associated with the combination of Agarwal and Prall be withdrawn for claims 38-39, 42-43 and 45-49.

Claims 40-43, 45 and 48

Claims 40-43, 45 and 48 depend from independent claim 38.

First, Applicants submit that claim 38 is nonobvious over the combination of Agarwal and Fukuzumi because Fukuzumi fails to remedy the defects of Agarwal with respect to claim 38. Applicants submit that Fukuzumi is merely cited as teaching forming electrodes from a number of alternative materials and forming a dielectric from a number of alternative materials. Even if taken as true, Applicants submit that claim 38 is still nonobvious over the combination of Agarwal and Fukuzumi.

Second, Applicants also submit that claim 38 is nonobvious over the combination of Agarwal, Prall and Fukuzumi because Fukuzumi fails to remedy the defects of Agarwal and Prall with respect to claim 38. Applicants submit that Fukuzumi is merely cited as teaching forming electrodes with a number of alternative materials and forming a dielectric with a number of alternative materials. Even if taken as true, Applicants submit that claim 38 is still nonobvious over

the combination of Agarwal, Prall and Fukuzumi.

Applicants further submit that claims 40-43, 45 and 48, which depend from claim 38, are nonobvious over the combination of Agarwal and Fukuzumi and are nonobvious over the combination of Agarwal, Prall and Fukuzumi. *See* MPEP § 2143.03 *id.*

Accordingly, Applicants respectfully request that the § 103(a) rejections associated with the combination of Agarwal and Fukuzumi and with the combination of Agarwal, Prall and Fukuzumi be withdrawn for claims 40-43, 45 and 48.

Claims 38-43 and 45-49

Applicants respectfully submit that independent claim 38 is nonobvious over the combination of Fukuzumi and Agarwal because, among other things, there is no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified these references to realize the invention of claim 38. *See* MPEP § 2143 *id.*

Applicants agree with the Examiner's determination that Fukuzumi fails to disclose, teach or suggest forming the second electrode on the uppermost surface of the substrate assembly as recited in claim 38. However, Applicants respectfully disagree with the Examiner's determination that it would have been obvious to combine Fukuzumi and Agarwal to construct a capacitor by the method recited in claim 38 because of "the desirability to form a trench capacitor having a planar electrode structure and to eliminate the step formed by patterning the second electrode and dielectric."

Applicants note that MPEP § 2143.01 specifically states that (1) the prior art must suggest the desirability of the claimed invention and (2) the level of skill in the art **can not be relied upon** to provide the suggestion to combine references.

Applicants also submit that a § 103(a) rejection of claim 38 based on the combination of Fukuzumi and Agarwal would be a hindsight reconstruction, using Applicants' claim as a template to construct a capacitor by the method recited in claim 38 by picking and choosing isolated disclosures from the prior art. Such hindsight reconstruction is improper and impermissible under the law. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143.01.

Applicants further submit that claims 39-43 and 45-49, which depend from claim 38, are also nonobvious over the combination of Fukuzumi and Agarwal. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the § 103(a) rejections associated with the combination of Fukuzumi and Agarwal be withdrawn for claims 38-43 and 45-49.

Claims 52-57

For reasons similar to those set forth hereinabove with respect to claim 38, Applicants respectfully submit that independent claim 52 is nonobvious over the combination of Fukuzumi and Agarwal because, among other things, there is no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified these references to realize the invention of claim 52. *See* MPEP § 2143 *id.*

Applicants also submit that claims 53-57, which depend from claim 52, are also nonobvious over the combination of Fukuzumi and Agarwal. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the § 103(a) rejections associated with the combination of Fukuzumi and Agarwal be withdrawn for claims 52-57.

Claims 58-60

For reasons similar to those set forth hereinabove with respect to claim 38, Applicants respectfully submit that independent claim 58 is nonobvious over the combination of Fukuzumi and Agarwal because, among other things, there is no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified these references to realize the invention of claim 58. *See* MPEP § 2143 *id.*

Applicants also submit that claims 59-60, which depend from claim 58, are also nonobvious over the combination of Fukuzumi and Agarwal. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the § 103(a) rejections associated with the combination of Fukuzumi and Agarwal be withdrawn for claims 58-60.

Claims 38-43 and 45-49

Applicants respectfully submit that independent claim 38 is nonobvious over the combination of Fazan, Agarwal and Fukuzumi because, among other things, there is no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified these references to realize the invention of claim 38. *See* MPEP § 2143 *id.*

First, Applicants note that Fukuzumi is not cited for teaching or suggesting any of the features of claim 38. Second, Applicants respectfully disagree with the Examiner's determination that it would have been obvious to combine Fazan and Agarwal to construct a capacitor by the method recited in claim 38 because of "the desirability to form a trench capacitor having a planar electrode structure and to eliminate the step formed by patterning the second electrode and dielectric." Applicants note that

MPEP § 2143.01 specifically states that (1) the prior art must suggest the desirability of the claimed invention and (2) the level of skill in the art **can not be relied upon** to provide the suggestion to combine references.

Applicants also submit that a § 103(a) rejection of claim 38 based on the combination of Fazan and Agarwal would be a hindsight reconstruction, using Applicants' claim as a template to construct a capacitor by the method recited in claim 38 by picking and choosing isolated disclosures from the prior art. Such hindsight reconstruction is improper and impermissible under the law. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143.01.

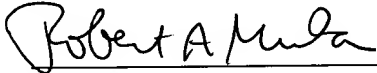
Thus, Applicants submit that claim 38 is nonobvious over the combination of Fazan, Agarwal and Fukuzumi. Applicants also submit that claims 39-43 and 45-49, which depend from claim 38, are also nonobvious over the combination of Fazan, Agarwal and Fukuzumi. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the § 103(a) rejections associated with the combination of Fazan, Agarwal and Fukuzumi be withdrawn for claims 38-43 and 45-49.

CONCLUSION

Applicants respectfully request a Notice Of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,

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